



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/016,509 | 12/10/2001 | Davide Libenzi | 002.0232.01 | 9083 |

22895 7590 04/26/2005

PATRICK J S INOUE P S
810 3RD AVENUE
SUITE 258
SEATTLE, WA 98104

EXAMINER

PEARSON, YVETTE B

ART UNIT PAPER NUMBER

2144

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/016,509

Applicant(s)

LIBENZI, DAVIDE

Examiner

Yvette Pearson

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>March 13, 2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1- 34 are presented for examination in the application.
2. Acknowledgement is made of Information Disclosure document filed March 6, 2002.
3. Acknowledgment is made of Provisional Application No. 60/309,835 filed on August 3, 2001 and Provisional Application No. 60/309,858 filed on August 3, 2001

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1 - 7, 9 – 16 and 18 - 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Foss et al (US 6,119,231).
5. As per Claims 1 and 10, Foss teaches a system for implementing message screening ([data scanning network security technique] Column 3, Lines 45 – 47) comprising:

- a). a system for intercepting an incoming message at a network domain boundary ([Mail Server] Column 3, Lines 64 – 66; Figure 2, #206) whereby the incoming message includes a header of a plurality of address fields storing content ([email message envelope] Column 3, Lines 59 – 64),
 - b). a stored set of blocking rules (protocol rules) such that each rule defines characteristics indicative of messages with bad content (Column 2, Lines 56 – 65),
 - c). a parser module identifying the contents of each address field ([a mail guard device for scanning all electronic mail messages sent to a network] Column 4, Lines 3 – 7, Lines 10 - 14; Figure 2, #207),
 - d). a comparison module checking the contents of each address field against the rules to screen bad messages and identify clean messages ([mail guard recognizes messages sent by known protocols] Column 4, Lines 30 – 34; Column 5, Lines 17 - 26), and
 - e.) an intermediate message queue staging clean messages pending further processing ([data is subsequently scanned for acceptable format content] Column 5, Lines 35 – 41.)
6. As per Claims 2 and 11, Foss teaches the method as described above wherein a message receiver discards each invalid message without further processing ([Column 4, Lines 35 – 42.]

7. As per Claims 3 and 12, Foss teaches the method as described wherein the blocking rules specify a regular expression containing one of literal value ([acceptable commands] Column 6, Lines 12 – 16.)
8. As per Claims 4, 5, 13 and 14, Foss teaches the method as described further comprising a scanner to scan each message in the intermediate message queue for bad content, wherein each scanning operation is performed as an event responsive to each clean message stage in the intermediate message queue ([data processed by searching algorithm] Column 5, Lines 52 – 64; Column 7, Lines 58 – 67.)
9. As per Claims 6 and 15, Foss teaches the method as described wherein a gateway receives the incoming messages into the network domain boundary ([Mail Server is responsible for in-coming and internal mail functions on the network] Column 3, Lines 48 – 58.)
10. As per Claims 7 and 16, Foss teaches the method as described wherein the structured fields comprise one of sender and recipient ([email envelope contains the IP address of e-mail source and destination] Column 3, Lines 59 – 64.)
11. As per Claims 8 and 18, Foss teaches the method as described wherein the distributed computing environment is TCP/IP compliant and the incoming message is SMTP compliant (Column 5, Lines 16 – 23.)
12. As per Claims 19 and 34, Foss teaches a computer readable medium for performing the method as described above that includes hardware and software elements of standard design (Column 8, Lines 16 – 27, Lines 53 – 56.)

Art Unit: 2144

13. As per Claims 20 and 27, Foss teaches a system for detecting malware ([data scanning network security technique] Column 3, Lines 45 – 47) comprising:

a). a system for receiving an incoming message packet from a sending client at a network domain boundary through an open connection ([Mail Server] Column 3, Lines 64 – 66; Figure 2, #206) whereby the incoming message comprises a header including address fields ([email message envelope] Column 3, Lines 59 – 64), and

b). a message receiver wherein a parser module parses field values of each address field of the incoming message packet ([a mail guard device for scanning all electronic mail messages sent to a network] Column 4 Lines 3 – 7, Lines 10 – 14; Figure 2, #207), and a comparison module to compare token characteristics indicative of malware to screen bad messages and identify clean messages ([mail guard recognizes messages sent by known protocols] Column 4, Lines 30 – 34; Column 5, Lines 17 – 26.)

14. As per Claims 21 and 28, Foss teaches the method as described above wherein an incoming message packet further comprises body storing message content, such that a scanner determines the body of the message content of the incoming message for malware to identify uninfected screened incoming message packets and forwards the uninfected screened incoming message packet ([the message portion of the email is checked] Column 6, Lines 1 – 7.)

15. As per Claims 22 and 29, Foss teaches the method as described further comprising a message queue enqueueing the screened incoming message ([data

scanning is further implemented by searching algorithm that can load data] Column 5, Lines 52 – 64; Column 7, Lines 58 – 67.)

16. As per Claims 23 and 30, Foss teaches the method as described wherein the system closes the open connection to the sending client of the non-screened incoming message packet ([system will end process if the protocol is not recognized by the Mail Guard device] Column 5, Lines 27 – 35.)

17. As per Claims 24 and 31, Foss teaches the method as described wherein the structured fields comprise one of sender and recipient ([email envelope contains the IP address of e-mail source and destination] Column 3, Lines 59 – 64.)

18. As per Claims 25 and 32, Foss teaches the method as described further comprising a stored set of blocking rules (protocol rules) to the field values of the header of the incoming message (Column 2, Lines 56 – 65); Column 4, Lines 10 – 14, Lines 30 – 34.)

19. As per Claims 26 and 33, Foss teaches the method as described wherein the distributed computing environment is TCP/IP compliant and the incoming message is SMTP compliant (Column 5, Lines 16 – 23.)

20. Thus, Foss discloses all limitations of the rejected claims; therefore Foss anticipates the subject matter of Claims 1 - 7, 9 – 16 and 18 - 34.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 8 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foss et al (US 6,119,231) in view of Chen et al (US 5,832,208).

21. With respect to claims 8 and 17, Foss teaches a system for implementing message screening ([data scanning network security technique] Column 3, Lines 45 – 47) comprising a system for intercepting an incoming message at a network domain boundary (Column 3, Lines 64 – 66; Figure 2, #206), a stored set of blocking rules such that each rule defines characteristics indicative of messages with bad content (Column 2, Lines 56 – 65), a parser module identifying the contents of each address field (Column 4, Lines 3 – 7, Lines 10 - 14; Figure 2, #207), a comparison module checking the contents of each address field against the rules (Column 4, Lines 30 – 34; Column 5, Lines 17 - 26), and an intermediate message queue staging clean messages pending further processing (Column 5, Lines 35 – 41), but fails to specifically teach a message screening system comprising an incoming message with an attachment. However Chen teaches a software program operating within a mail system to detect and remove a computer virus that may be located in email attachments (Column 5, Lines 1 – 4, Lines 18 – 21) whereby such method may be operating on a local area network such to utilize

a gateway with access to an external computer network, or such said system adapted to a wide area network (Column 6, Lines 25 – 33, Lines 49 – 51.)

Therefore, it would have been obvious to one having ordinary skill in the art having the teachings of Foss and Chen before one at the time of the invention to include the email-attachment-screening functionality coupled to the Mail Guard device ([Foss] Column 3, Line 67; Column 4, Lines 1 – 4; Figure 2, #207.) The combination would provide a more comprehensive network security system for determining the nature and type of email messages being sent to the network by the mail server device, such that the network could reject or translate/sanitize those e-mail messages that may harm the network thereby providing the enhanced and efficient security mechanism for the network. ([Foss] Column 2, Lines 29 –37.)

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

23. US 2002/0016826, (Johansson et al) discloses a method of controlling data between networks utilizing a firewall apparatus comprising filtering means, depending on the contents in data fields of a data packet.

Art Unit: 2144

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvette Pearson whose telephone number is 571 272-4227. The examiner can normally be reached on 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Cuchlinski can be reached on 571 272-3925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yvette Pearson

Examiner

Art Unit 2144



WILLIAM A. CUCHLINSKI, JR.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600